

## REMARKS

### OBJECTION TO CLAIM 9 AND 16

The Examiner objects to claim 9 and 16 because the word "axicon" is allegedly a trademark. In fact, "axicon" is a well-known term of art for a particular type of lens.

Accordingly, Applicant requests withdrawal of this objection to claims 9 and 16.

### DOUBLE PATENTING REJECTION

The Examiner rejects claims 1-16 on the grounds of obviousness-type double-patenting. However, the Examiner has not specifically identified which pairs of claims are deemed to recite patentably indistinct subject matter.

In response, Applicant points out that the pending claims all include the limitation of a beam re-director. None of the *Zuluaga* claims recite such a limitation.

In addition, the pending claims recite "a lens disposed inside the housing to intercept a rotating collection beam emerging from the eccentric port." No such limitation is apparent in *Zuluaga*'s claims.

In view of the foregoing differences, it is not clear why the subject matter of the pending claims and that claimed by *Zuluaga* are considered patentably indistinct. Applicant invites the Examiner to set forth reasons for such a finding.

Moreover, since the double-patenting rejection failed to specify the particular claim pairs deemed to be patentably indistinct and the reasons therefor, Applicant submits that the office action is not in compliance with Rule 1.104(c)(2). Accordingly, Applicant requests that any subsequent office action be non-final or that the double-patenting rejection be withdrawn.

### SECTION 102(f) REJECTION

The Examiner rejects claims 1-16 under 35 USC 102(f).

According to MPEP 706.02(g),

"[t]he examiner must presume the applicants are the proper inventors unless there is proof that another

made the invention and that applicant derived the invention from the true inventor.”

The citation of *Zuluaga* is insufficient to support rejection under section 102(f) because

“[d]erivation requires complete conception by another and communication of that conception by any means to the party charged with derivation prior to any date on which it can be shown that the one charged with derivation possessed knowledge of the invention.”<sup>1</sup>

The communication of that conception

“must be sufficient to enable one of ordinary skill in the art to construct and successfully operate the invention.”<sup>2</sup>

In view of the absence of the required evidence, Applicant requests withdrawal of the section 102(f) rejection.

#### **SECTION 102(e) REJECTION OF CLAIM 1**

The Examiner rejects claim 1 and its progeny under 35 USC 102(e) as being anticipated by *Seibel*.

According to the office action, the Examiner considers the limitation of “a housing with a rotatable distal face and a stationary proximal face, the distal face having an eccentric port and a central port” to be met by element 238 in FIG. 5F. The eccentric port of this “housing 238” is allegedly element 202 in FIG. 5D.

Applicant is puzzled by this purported correspondence. After all, element 238 is a lens, not a housing.<sup>3</sup> It is unclear how the Examiner can equate Applicant's claimed housing with lens 238.

In addition, the purported “eccentric port” of the housing, which the Examiner appears to regard as being any one of the optical fibers 202 in FIG. 5D, is not even part of what the Examiner regards as a housing, i.e., the lens 238. Accordingly, none of the optical fibers 202 can be a port in a distal face of a housing.

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<sup>1</sup> MPEP 2137, quoting *Kilbey v. Thiele*, 199 USPQ 290, 294 (Bd. Pat. Inter. 1978).

<sup>2</sup> Id. quoting *Hedgewick v. Ackers*, 497 F.2d at 908, 182 USPQ at 169 (CCPA 1974).

<sup>3</sup> *Seibel*, col. 14, lines 55-57.

The Examiner has not clearly identified where the “central port” is. It is, however, possible to interpret the Examiner’s comments as suggesting that the optical fibers 202 are regarded as being both central ports and eccentric ports. This appears to be a contradiction however. It is unclear how a “port” 202 can simultaneously be both a central port and an eccentric port of a distal face.

The Examiner has not identified where *Seibel* discloses

“a lens disposed inside the housing to intercept a rotating collection beam emerging from the eccentric port and to re-direct the collection beam to a focus proximal to the lens as the collection beam rotates”.

Nor has the Examiner identified where *Seibel* discloses

“a beam re-director disposed between the lens and the distal face, the beam re-director being oriented to direct a delivery beam toward the central port.”

Instead, the Examiner has drawn attention to the same lengthy passage that discusses three different figures, two of which show lenses, and none of which show the required beam re-director.

Rather than speculate on what the Examiner might have been thinking, Applicant requests that, consistent with Rule 1.104(c)(2), the Examiner precisely identify what is believed to correspond to both the claimed beam-redirector and to the claimed lens.

#### **SECTION 102(e) REJECTION OF CLAIM 10**

The Examiner rejects claims 10 and its progeny under 35 USC 102(e) as being anticipated by *Seibel*.

To the extent that the limitations of claim 10 are similar to those of claim 1, Applicant reiterates the arguments set forth above in connection with claim 1.

Claim 10 recites the further limitation of

“a rotating catheter having a collection fiber and a delivery fiber extending therethrough.”

The Office Action does not identify what the Examiner regards as corresponding to the this rotating catheter. The only rotating structure readily apparent is *Seibel* is the optical fiber **208** in FIG. 5D, which moves in response to the piezoelectric actuator **206**. However, this rotating fiber **208** lacks “a collection fiber and a delivery fiber extending therethrough.”

Rather than speculate further on what the Examiner might have been thinking, Applicant requests that, consistent with Rule 1.104(c)(2), the Examiner precisely identify what is believed to correspond to the claimed rotating catheter.

#### **SECTION 102(e) REJECTION OF CLAIMS 3-5, 9, 11-14, 16**

Claims 3 and 4 recite the further limitation that the beam re-director comprise a penta-prism and a prism respectively. Claims 12 and 13 recite similar limitations.

##### **Claim 4 and 13**

Claims 4 and 13 require that the beam re-director comprise a prism.

In rejecting claims 4, and 13, the Examiner draws attention to text describing FIG. 6B's disclosure of a spectrophotometer **272** that uses a prism or grating in connection with measurement of spectra. However, this prism appears to be located outside the optical fiber assembly **250** altogether. Hence, the prism in the spectrophotometer **272** cannot possibly be both “disposed between the lens and the distal face [of the housing]” and “oriented to direct a delivery beam toward the central port”.

##### **Claim 3 and 12**

With regard to claims 3 and 12, the Examiner states that the purpose of a penta-prism is not defined, and that therefore the limitation amounts to a mere design choice. The Examiner then proceeds to ignore this limitation and to treat these claims as being identical to claims 4 and 13. These claims are thus rejected as being anticipated by a reference that, at best, discloses a prism, and not a penta-prism.

Applicant is unaware of any requirement that the claim recite the purpose of a structure. A proper section 102 rejection requires that for each claim limitation, the Examiner identify a

corresponding structure. If the Examiner cannot identify such a structure, the rejection is improper. The "purpose" of a structure is irrelevant in this analysis.

The plain fact is that the claim requires a penta-prism, and the reference does not show the penta-prism. Therefore, the reference cannot anticipate the claim.

**Claim 5 and 14**

Claim 5 and claim 14 require that the beam re-director comprise a mirror. In rejecting these claims, the Examiner draws attention to the three mirrors **532, 354, 356** shown in FIG. 7A.

Claim 5 includes the limitation that the beam re-director be "disposed between the lens and the distal face [of the housing]" and that the beam re-director be "oriented to direct a delivery beam toward the central port [of the distal face of the housing]." None of the three mirrors meet this limitation.

The three mirrors appear to be disposed between a lens **358** and any of four light sources **342, 344, 346, 348**. This is different from being "disposed between the lens and the distal face [of the housing]" as required by the claim.

In addition, the mirrors do not appear to be "oriented to direct a delivery beam toward the central port [of the distal face of the housing]." They are in fact oriented to direct a delivery beam toward a lens **358**, which then directs the beam into an optical fiber **360**.

**SECTION 102(e) REJECTION OF CLAIMS 9 AND 16**

Claims 9 and 16 recite the limitation that the lens comprise an axicon lens. In rejecting these claims, the Examiner has drawn attention to what is regarded as a disclosure of prisms and mirrors.

The prisms and mirrors that the Examiner has drawn attention to are not axicon lenses. Hence, they fail to disclose or suggest the claim limitation. Accordingly, Applicant requests reconsideration and withdrawal of this rejection.

### DEPENDENT CLAIMS

The remaining claims are dependent on either claim 1 or claim 10. Those claims are therefore patentable for at least the same reasons discussed above in connection with their respective parent claims.

### SUMMARY

Applicant has presented only selected reasons for urging patentability of the claims. This is not intended as an admission that no other reasons exist.

Now pending in this application are claims 1-16, of which claims 1 and 10 are independent. No additional fees are believed to be due in connection with the filing of this response. However, to the extent fees are due, or if a refund is forthcoming, please adjust our deposit account 06-1050, referencing attorney docket "12258-036001."

Respectfully submitted,

Date: February 9, 2005



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